

**REPLY/AMENDMENT
FEE TRANSMITTAL**

Attorney Docket No. 95-460

Application Number 09/846,225

Filing Date May 2, 2001

First Named Inventor GRESS

Group Art Unit 2681

AMOUNT ENCLOSED

\$ 0

Examiner Name

RAMOS-FELICIANO, Eliseo

RECEIVED

SEP 17 2004

Technology Center 2604

FEE CALCULATION (fees effective 10/01/2003)

CLAIMS AS AMENDED	Claims Remaining After Amendment	Highest Number Previously Paid For	Number Extra	Rate	Calculations
TOTAL CLAIMS	42	42	0 ⁽³⁾	X \$18.00 =	\$0
INDEPENDENT CLAIMS	4	4	0	X \$86.00 =	\$0
Since an Official Action set an <u>original</u> due date of ____, petition is hereby made for an extension to cover the date this reply is filed for which the requisite fee is enclosed (1 month (\$110); 2 months (\$420); 3 months (\$950); 4 months (\$1,480); 5 months (\$2,010)):					
If Statutory Disclaimer under Rule 20(d) is enclosed, add fee (\$110)					+
Total of above Calculations =					\$0
Reduction by 50% for filing by small entity (37 CFR 1.9, 1.27 & 1.28)					-
TOTAL FEES DUE =					\$0

- (1) If entry (1) is less than entry (2), entry (3) is "0".
(2) If entry (2) is less than 20, change entry (2) to "20".
(4) If entry (4) is less than entry (5), entry (6) is "0".
(5) If entry (5) is less than 3, change entry (5) to "3".

METHOD OF PAYMENT

- ☐ Check enclosed as payment.
☐ Charge "TOTAL FEES DUE" to the Deposit Account No., below.

AUTHORIZATION

- ☒ If the above-noted "AMOUNT ENCLOSED" is not correct, the Commissioner is hereby authorized to credit any overpayment or charge any additional fees under 37 CFR 1.16 or 1.17 necessary to maintain pendency of the present application to:

Deposit Account No.: 50-1130

OrderNo.: (Client/Matter) 95-460

SUBMITTED BY: LEON R. TURKEVICH, ESQ.

Typed Name	Leon R. Turkevich	Reg. No.	34,035
Signature		Date	September 16, 2004



Doc. No.: 95-460

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

GRESS et al.

Serial No.: 09/846,225

Filed: May 2, 2001

:
:
:
:
:

: Group Art Unit: 2681

: Examiner: RAMOS-FELICIANO, Eliseo

For: UNIFIED MESSAGING SYSTEM CONFIGURED FOR CONVERTING SHORT
MESSAGE SERVICE MESSAGES TO AUDIBLE MESSAGES

RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED

SEP 17 2004

Technology Center 2600

Sir:

In response to the Official Action mailed June 16, 2004, Applicant hereby submits the following remarks.

Reconsideration and the allowance of the above-referenced application are respectfully requested. Claims 1-42 are unchanged and remain pending in the application.

Claims 1, 3-5, 7-8, 12, 14, 16, 20, 22-24, 26-27, 31, 33-35, and 37-38 stand rejected under 35 USC §103 in view of Schwelb et al., Jones, and of Luther. This rejection is respectfully traversed. Applicant's arguments submitted April 2, 2004 are incorporated in their entirety herein by reference. The following comments elaborate on Applicant's April 2, 2004 arguments and address the issues raised in the June 16, 2004 Official Action.

Response filed September 16, 2004
Appln. No. 09/846,225
Page 1

Applicant strenuously traverses the mischaracterization of Applicant's arguments by the Examiner on page 7 of the Official Action. Applicant has not relied on unclaimed features, as asserted by the Examiner, but rather has illustrated inherent properties that provide advantages over that prior art and that arise from use of the invention, and as such are part of the invention as a whole.

As stated in MPEP § 2141.02 on page 126:

In determining whether the invention as a whole would have been obvious ... we must first delineate the invention as a whole. In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question ... but also to those properties of the subject matter which are inherent in the subject matter and are disclosed in the specification."

(Quoting In re Antonie, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977) (emphasis added).

As described in the specification on page 3, lines 25-27, page 4, lines 1-3, 10-12, and 18-20, and page 10, lines 8-13, these features are inherent properties that cannot be disregarded in an obviousness analysis. Moreover, it is well settled that in an obviousness analysis the claimed structures and methods cannot be divorced from the problems addressed by the inventor and the benefits resulting from the claim invention. In re Newell, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

Hence, the inherent property of *enabling* an originator of the SMS message to request conversion of the text-based message into an audible message is based on the claimed feature of receiving an SMS message that specifies a text-to-speech messaging command, detecting the text to speech messaging command during parsing by the server, invoking the text to speech resource, and outputting the audible message generated by the text-to-speech resource.

Further, the Examiner asserts in paragraph 10 that applicant supposedly attacks references

individually. However, however, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. MPEP §2141.02, page 2100-127 (Rev. 2, May 2004) (citing W.L. Gore & Assoc. v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)).

Applicant's arguments address the inconsistencies in the reference that would lead one skilled in the art to not combine the references. Hence, Applicant is not arguing the references individually, but rather is attacking the rejection in its entirety.

Applicant also traverses the assertion in paragraph 11 that Luther could be considered analogous art based on the Examiner's assertion that "the common field to Schwelb et al. and Jones is text-to-speech messaging." The legal standard, however, is not the common field of the applied references, but whether the reference is within the field of the inventor's endeavor.

The specification explicitly describes on page 1, lines 2-3 that "[t]he present invention relates to unified messaging systems configured for receiving, storing, and supplying Short Message Service (SMS) messages to a subscriber." Further, each of the independent claims 1, 12, 20, 31 specify that the invention is directed to "a server configured for executing messaging operations." Hence, the field of the inventor's endeavor is unified messaging systems configured for receiving, storing, and supplying SMS messages.

In contrast, Luther explicitly specifies that the field of its invention is:

a system for scripting a text-to-speech based multimedia presentation, and in particular, to a system in which a scripting file which includes text narration and multimedia commands is processed so as to separate the text from the commands, to enunciate the text narration, and to execute the multimedia commands."

(Column 1, lines 5-14).

Hence, Luther is not analogous art because it is directed to a system configured for scripting a text-to-speech based multimedia presentation (including MIDI music presentations, still video and motion video images, animated images, etc.)(see col. 1, lines 5-57). As apparent from the foregoing, the field of providing a text-to-speech based multimedia presentation is not analogous to providing a unified communications system configured for receiving, storing and supplying SMS messages (in the present application). As noted by the MPEP § 2141.01 (a), page 2100-122, the differences in structure and function of the inventions carry far greater weight in determining that a reference is not analogous art.

Finally, the Official Action fails to address the arguments of pages 15-16 of the April 2, 2004 Amendment . In particular, one skilled in the art would not have been motivated to add the teachings of Luther, since Luther has no relevance to the transfer of SMS messages; moreover, the asserted motivation for adding Luther ("to avoid the possibility of desynchronization between the speech commands and the text with which is commands are associated") is nonsensical in the context of converting SMS messages to speech. Although the synchronization taught by Luther is of importance in multimedia presentations, the synchronization is nonexistent in the case of a text message being converted to an audible message, because SMS message systems do not provide for concurrent presentation of text and audio.

Further, the Official Action fails to address the deficiencies in the hypothetical combination of Schwelb et al., Jones, and Luther, as described in detail on pages 16-17 of the April 2, 2004 Amendment.

Hence, the Official Action is deficient because it fails to respond to all the material traversed. (See MPEP §707.07(f): "Where the applicant traverses any rejection, the Examiner should, if he or she repeats the rejection, take note of the applicant's arguments and answer the substance of it.")

Finally, Figure 4 of Luther provides an example of a multimedia scripting file that is stored in mass storage memory 20 and that is executed by the CPU 11 for scripting a multimedia presentation (col. 5, lines 44-46). One skilled in the art would not have been motivated to add the teachings of Luther, especially since the scripting file illustrated in Figure 4 in no way can be considered equivalent to an SMS message, especially since the substantially large size of the scripting file would exceed the capacity of cellphones and SMS message constraints.

Further, Luther does not disclose or suggest parsing a message, but rather executing a script file. As described above, Luther has no relation whatsoever to unified messaging, let alone SMS messaging; as such, one having ordinary skill in their would not have been motivated to apply the teachings of Luther in order to add the claimed feature of detecting the text-to-speech messaging command during parsing of the SMS message.

For these and other reasons, the rejection in view of Schwelb et al., Jones, and Luther should be withdrawn.

Claims 6, 9-11, 13, 15, 17-19, 25, 28-30, 36, and 39-41 stand rejected under 35 USC §103 in view of Schwelb et al., Jones, Luther, and U.S Patent No. 6,665,378 to Spielman. This rejection is respectfully traversed, because Spielman et al. is not available as a reference under 35 USC §103(c).

The Examiner's attention is directed to the Statement of Common Ownership specified on

page 18 of the Amendment filed April 2, 2004. The Statement of Common Ownership specifies that the subject application and U.S Patent No. 6,665,378 to Spielman et al. were owned by, or subject to an obligation of assignment to, the same entity. Since the Official Action fails to identify any deficiency with the Statement of Common Ownership, Applicant presumes that the continued use of Spielman et al. in the rejection of claims 6, 9-11, 13, 15, 17-19, 25, 28-30, 36, and 39-41 was an oversight by the Examiner.

Further, the Official Action fails to provide any reason why the Statement of Common Ownership is not acceptable. The Statement of Common Ownership is compliant with the Guidelines specified in the Official Gazette (See 1241 OG 96 (Dec. 26, 2000)). Hence, the §103 rejection of these claims based on Spielman et al. should be withdrawn, because Spielman et al. is not available as a reference under §103(c).

Claims 2, 21, 32, and 42 stand rejected under 35 USC § 103 in view of Schwelb et al., Jones, Luther, and US Patent Application Publication 2003/0078989 by Ladd. This rejection is respectfully traversed. The Examiner asserts that "in a server, the message is processed by a text-to-speech processor (par. 0035)", and that "inherently, the message must contain the processor's 'destination number' in order to be properly processed."

This rejection is improper because inherency is not applicable in a rejection under §103. In re Newell, 13USPQ2d 1248, 1250 (Fed. Cir. 1989). Moreover, paragraph 22 teaches that many PCS digital phone systems are capable of providing caller ID to the called party, and that PCS digital phones also have a short message service whereby short pages are displayed on an LCD screen built into the PCS phone. Paragraph 22 also teaches that "the server 30 is therefore programmed to

automatically associate calling party by the phone number of the calling party, and stores this number as the identification of the information device to which the directions will be sent once they are retrieved.”

Hence, Ladd actually teaches using the caller ID telephone number of the user's PCS digital phone number.

In contrast, claims 2, 21, 32 and 42 specify that the receiving includes determining that the SMS message includes a destination number that corresponds to an SMS command processor within the server. Hence, the claimed destination number specifies the command processor, and not a user's digital PCS telephone number, as described in Ladd.

For these and other reasons, this rejection of claims 2, 21, 32, and 42 should be withdrawn.

In view of the above, it is believed this application is in condition for allowance, and such a Notice is respectfully solicited.

To the extent necessary, Applicant petitions for an extension of time under 37 C.F.R. 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including any missing or insufficient fees under 37 C.F.R. 1.17(a), to Deposit Account No. 50-1130, under Order No. 95-460, and please credit any excess fees to such deposit account.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'L R Turkevich', with a stylized flourish at the end.

Leon R. Turkevich

Registration No. 34,035

Customer No. 23164
(202) 261-1059
Date: September 16, 2004